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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,701	12/03/2003	Chi Fai Ho	PROQP001C5	8639

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EXAMINER	
CHENG, JOE H	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,701	HO ET AL.	
	Examiner	Art Unit	
	Joe H. Cheng	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☒ Claim(s) 21-30 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 03 December 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1/9/04;4/5/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The term "

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a continuation of co-pending U.S. Patent Application No. 10/295,503, filed on November 14, 2002, which is a continuation of U.S. Patent Application No. 09/347,184, filed on July 2, 1999, now U.S. Patent No. 6,501,937, which is a continuation of U.S. Patent Application No. 09/139,174, filed on August 24, 1998, now U.S. Patent No. 5,934,910, which is a continuation of U.S. Patent Application No. 08/758,896, filed on December 2, 1996, now U.S. Patent No. 5,836,771; with the applications and patent being incorporated herein by reference into this application.

This application is a continuation of co-pending U.S. Patent Application No. 10/060,120, filed on January 28, 2002, which is a continuation of U.S. Patent Application No. 09/387,932, filed on September 1, 1999, now U.S. Patent No. 6,498,921, which is a continuation-in-part1 of U.S. Patent Application No. 09/347,184, filed on July 2, 1999, now U.S. Patent No. 6,501,937, which is a continuation of U.S. Patent Application No. 09/139,174, filed on August 24, 1998, now U.S. Patent No. 5,934,910, which is a continuation of U.S. Patent Application No. 08/758,896, filed on December 2, 1996, now U.S. Patent No. 5,836,771, the disclosure of which are incorporated herein by reference." on page 1, line 1 should be recited as --

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a continuation of U.S. Patent Application No. 10/295,503, filed on November 14, 2002, now abandoned, which is a continuation of U.S. Patent Application No.

09/347,184, filed on July 2, 1999, now U.S. Patent No. 6,501,937, which is a continuation of U.S. Patent Application No. 09/139,174, filed on August 24, 1998, now U.S. Patent No. 5,934,910, which is a continuation of U.S. Patent Application No. 08/758,896, filed on December 2, 1996, now U.S. Patent No. 5,836,771; with the applications and patent being incorporated herein by reference into this application.

This application is also a continuation of U.S. Patent Application No. 10/295,503, filed on November 14, 2002, now abandoned, which is a continuation of U.S. Patent Application No. 10/060,120, filed on January 28, 2002, now abandoned, which is a continuation of U.S. Patent Application No. 09/387,932, filed on September 1, 1999, now U.S. Patent No. 6,498,921, which is a continuation-in-part1 of U.S. Patent Application No. 09/347,184, filed on July 2, 1999, now U.S. Patent No. 6,501,937, which is a continuation of U.S. Patent Application No. 09/139,174, filed on August 24, 1998, now U.S. Patent No. 5,934,910, which is a continuation of U.S. Patent Application No. 08/758,896, filed on December 2, 1996, now U.S. Patent No. 5,836,771, the disclosure of which are incorporated herein by reference.--, so as to clarify the status.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 5,836,771. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of "repeating, by the system, at least the steps of retrieving (c), generating (d) and presenting (e), so as to answer another question entered by the user on the subject" (as per claim 1) and "optionally repeating, by the system, the steps of retrieving, generating and presenting, so as to answer another question entered by the user on the subject" (as per claim 3) are obvious alternative languages since these merely describe the "repeating, by the system, the steps of retrieving, presenting, retrieving, generating and presenting, so as to answer another question entered by the user on the subject". Hence, the instant claims do not differ from the scope of the patented claim 15. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

6. Claims 2 and 4-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-14, 28, 29, 32, 34, 35 and 37-39 of U.S. Patent No. 6,480,698 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of "study material of the subject" (as per claims 2 and 4) and "at least one response associated with the subject" (as per claim 7) are obvious alternative languages since these merely

describe the "information on a subject for the user to learn about the subject" and "a plurality of response associated with the subject". Hence, the instant claims do not differ from the scope of the patented claims 1, 32, 34 and 37. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

7. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 75 of U.S. Patent No. 6,501,937 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of "server system", "client system" and "at least analyze the natural-language question using at least grammatical processing" are obvious alternative languages since these merely describe the "first system", "second system" and "at least analyze the natural-language question using at least grammatical and semantic processing". Hence, the instant claims do not differ from the scope of the patented claim 75. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

Conclusion

7. Claims 21-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
May 7, 2004